

## **REMARKS**

### **AMENDMENTS TO THE SPECIFICATION**

- 5           The amendment to page 9, line 25, to page 10, line 7, removes the reference to the Food, Drug and Cosmetic Act, to which the Examiner had objected.

### **AMENDMENTS TO THE CLAIMS**

- 10           The amendments to the claims have been made in the interests of speedy prosecution, and without prejudice to Applicant's right to prosecute other claims, including the canceled claims, in one or more continuing applications.

- 15           Claim 59 has been amended by adding to the list of oils in the Markush group "octanoates of glycol, octanoates of glycerol, decanoates of glycol, decanoates of glycerol, and cetyl ricinoleate". These oils were previously in Claim 67, but have been canceled from claim 67 in view of the Examiner's objection to claim 67.

- 20           Claims 78, 81, 92-99, and 121-129 have been canceled in view of the Examiner's rejections.

          Claims 90 has been amended to correct its dependency, and claim 109 has been canceled, in view of the Examiner's objections.

- 25           It is believed that the amendments to the specification and claims can properly be made at the present stage, since the amendments are made in answer to the Examiner's objections and rejections; do not raise any new issues; and place the application in better condition for any appeal that may be necessary.

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## THE OBJECTIONS AND REJECTIONS

### 5    The Objections

As noted above, the specification has been amended to remove the objection of new matter in the specification; claim 90 has been amended so that it is no longer dependent on a canceled claim; and claim 109 has been canceled.

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Claims 65-67 were objected to as being improperly dependent on claim 59. The Examiner is asked to reconsider this objection in view of the amendment made to claim 67 and the following facts.

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Claim 59 includes "triglycerides" as one member of the Markush group set out therein. Vegetable oils are triglycerides, and it is, therefore, appropriate for claim 65 to refer to vegetable oils, thus further limiting claim 59. Thus, column 3, line 47, of Morawsky (US Patent No. 5,736,125) refers to "the triglycerides, especially the vegetable oils".

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Claim 66 lists a number of specific vegetable oils, as listed in column 3, lines 47-50, of Morawsky, and it is, therefore, similarly appropriate for claim 66 to refer to them, thus further limiting claim 59.

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Claim 67 has been amended by deleting the references to dimethyl polysiloxane, phenyl dimethicones, octanoates of glycol, octanoates of glycerol, decanoates of glycol, decanoates of glycerol, and cetyl ricinoleate, since it is agreed that these oils do not further limit any of the oils recited in claim 59. The remaining oils are specific examples of one of the oils in the Markush group in claim 59. Thus, perhydrosqualene is an animal oil, as listed in claim 59 (see Morawsky, column 3, line 60, "the animal oils, such as perhydrosqualene"); and isopropyl lanolate and isocetyl lanolate are esters derived from lanolic acid, as listed in claim 59 (see Morawsky, column 3, line 66-67).

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### The Restriction Requirement

5            Claims 121-129 have been canceled in view of the restriction requirement, and will be made the subject of a divisional application.

### The Rejections under 35 U.S.C. 102 and 35 U.S.C. 103

10           Applicants respectfully traverse the rejection of  
              (1)      claims 110-119 under 35 U.S.C. 102 as anticipated by, or in the  
                 alternative obvious over, McCoy et al. U.S. Patent No. 3,894, 958 ("McCoy"),  
                 Song et al. U.S. Patent No. 3,892,671 ("Song") or Kaneshige et al. U.S. Patent  
                 No. 4,877,557 ("Kaneshige"); and  
15           (2)      claims 78, 81 and 92-99 as obvious over McCoy, Song or Kaneshige, in  
                 view of in view of Honda Motor Co. JP-59-185813 ("Honda") or Hitachi Cable Ltd.  
                 JP- 07-220531 ("Hitachi"),  
insofar as those rejections are applicable to the amended claims, for the following  
reasons.

20           With regard to rejection (1), claim 110 has been amended to remove "colorants,  
                 pigments and silicones" from the list of possible additives. Thus, amended claim 110  
                 now requires that the composition contains at least one additive selected from  
                 sunscreen agents, deodorants, pharmaceuticals and antiseptic agents. The  
25           references do not disclose such additives. The Examiner has not suggested that there  
                 is any reason why it would have been obvious to one of ordinary skill in the art to add  
                 such additives to the lubricating oil compositions disclosed in these references; and, for  
                 the sake of completeness, Applicant asserts that there is no such reason. The rejection  
                 should, therefore, be withdrawn.

30           For the sake of completeness, it is noted that

(1) the rejection over McCoy depends upon an unjustified assumption that the "polymethacrylate thickeners" referred to in McCoy meet the requirements of paragraph (2)(a) of claim 110;

(2) the rejection over Song ignores the fact that Song requires the use of a polymer which contain units derived from a nitrogen-containing monomer (see column 2, lines 27-29, column 10, lines 61-68, and column 3, lines 23-35), and which do not, therefore, meet the requirement of paragraph(2)(d) of claim 110; and

(3) the rejection over Kaneshige

(i) depends upon an unjustified assumption that the "polymethacrylic acid esters" referred to in Kaneshige meet the requirements of paragraph (2)(a) of claim 110;

(ii) ignores the fact that such polymethacrylic acid esters do not meet the requirement of paragraph(2)(d) of claim 110, and

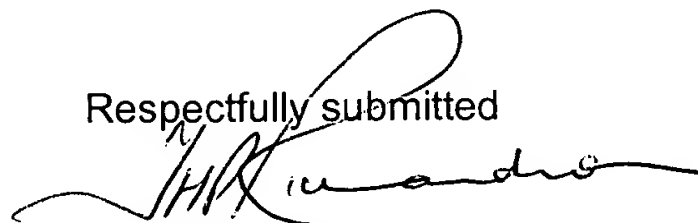
(iii) depends upon an unjustified assumption that the "polyalkylmethacrylates" referred to in Kaneshige meet the requirements of paragraph (2)(a) of claim 110.

With regard to rejection (2), as noted above, claim 78, 81 and 92-99 (dependent on claim 78) have been canceled, thus obviating the rejection.

### **CONCLUSION**

It is believed that this application is now in condition for allowance. If, however, there are any outstanding issues that could usefully be discussed by telephone, the Examiner is asked to call the undersigned.

Respectfully submitted



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